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09/763,085	04/30/2001	Isabelle Bara	05725,0852	2724

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EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,085

Applicant(s)

BARA, ISABELLE

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 27-83 are pending. Claims 27, 47, 51, 60, 71 and 80-83 have been amended in the amendment filed March 12, 2003, Paper No. 15.

Information Disclosure Statement

1. The reference number 8 of the IDS filed April 30, 2001 did not appear with the other references and was not considered. In view of applicants stamped post card receipt, the reference has been considered and is cited on the Office Form PTO-892. It is noted said reference was cited in the international search report as an A reference. The examiner regrets any inconvenience.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 27-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Several of the claims contain improper alternative groupings that should be corrected. Attention is directed to MPEP 2173.05(h). An example may be found in claim 28 where the grouping does not use closed language and employs "and" several times. Said grouping is indefinite as to the scope of its members and the grouping. It is suggested applicants insert - - the group consisting of - - after chosen from and amend the groups to remove multiple use of "and".

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Several of the claims employ the species as derivatives but fail to define how said materials are derived or what said derivatives consist. It is unclear what are the scope of the derivatives contemplated. See claim 28 wherein applicants set forth the limitations of "protein derivatives" and "derivatives thereof". It is further unclear what is the scope of a "derivative of" a "protein derivative". Other examples may be found in claim 35.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 27-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/17055¹ to L'Oreal, as evidenced by patent family member document Roulier et al US 6,045,814 (hereafter Roulier et al '814), taken with Roulier et al, US 6,280,750 (hereafter Roulier et al '750).

Roulier et al '814 is an English language patent family member of WO 97/17055. Attention is directed to the Roulier et al '814 patent face items [86], [87], and [30]. WO 97/17055 was published May 15, 1997 and the date qualifies as prior art under 35 USC 102(b). The disclosures are expected to be the same or substantially the same. The Roulier et al '814 reference is referred to hereafter.

¹ WO 97/17055, FR 2740,678, and US 6,045,814 are all believed to belong to the same patent family.

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Applicants define their solid gels at page 6, lines 6-17. The gels in the Roulier et al '814 reference are defined at column 1, lines 19-29, wherein the gels of the Roulier et al '814 reference and those instantly claimed at least overlap in the gel strength.

Furthermore, the gel strength is directly proportional to the concentration of the gelling agent in the gel, *i.e.*, an increase in gelling agent generally increases the gel strength.

Roulier et al '814 (column 3, lines 15 et seq, particularly lines 24-29) discloses the use of cellulose derivatives as hydrophilic gelling agents. Roulier et al '814 (column 3, lines 13-14, and the claims) set forth one or more hydrophilic gelling agents.

Roulier et al '814 (column 4, lines 44 et seq, particularly 60 et seq, and examples) discloses pigments and pearlescing pigments that read on the claimed pulverulent phase.

Roulier et al '814 differs in the concentration of said gelling agents in the solid gels and the combination of gelling agents taught in the prior art for said same purpose as gelling agents.

Roulier et al '814 exemplifies the use of a seed extract including carob gum. Roulier et al '814 (column 3, lines 15-40) teaches numerous gelling agents that may be employed including alga extracts including carrageenans and alginates; seed extracts including carob gum; and microorganism exudates including xanthan and cellulose carboxymethyl-, hydroxyalkyl- and alkyl-substituted derivatives among other gelling agents. Roulier et al '814 (abstract ; column 3, lines 41 et seq; and claims) disclose the gelling agent concentration ranges from 20% by weight to 80% by weight or at least 20% by weight rather than the less than 20% by weight instantly claimed.

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Roulier et al '814 (column 7, lines 57 et seq) discloses a number of pigments and pearlescing agents including organic dyes and inorganic pigments in concentrations of 2 to 30 % by weight.

Roulier et al '750 (abstract ; column 2, lines 24-33; column 2, line 52 to column 3, line 8 ; examples and claims) discloses solid gel compositions employing a combination of gellan gum and at least one other hydrocolloid including cellulose derivatives.

Roulier et al '750 (column 2, lines 24-33) discloses the gel strength of the said gels.

Roulier et al '750 (column 2, lines 52 et seq) discloses the concentrations of the gelling agents wherein the preferred concentrations of the combination reads on the claimed concentration.

These references are combinable because they teach cosmetic gels. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ gellan gum in combination with a cellulose derivative as taught in the Roulier et al '750 reference as an obvious gelling agent contemplated in the Roulier et al '814 compositions at concentrations of less than 20 % by weight to form the gels taught in the Roulier et al '814 reference.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ the pulverulent phase disclosed in the Roulier et al '814 reference as an obvious powder phase components conventionally use in cosmetics.

Furthermore, it is generally prima facie obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in

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order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, both the cellulose derivatives and the gellan gums are taught as gelling agents in the Roulier et al '814 reference.

Regarding claims 78 and 79, Roulier et al '814 sets forth the fatty phase as a further ingredient in concentrations of "up to 20% by weight". Said concentrations read on zero% by weight.

5. Claims 27-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/17055 to L'Oreal, as evidenced by patent family member document Roulier et al US 6,045,814 (hereafter Roulier et al '814) in view of with Intercos Italia S.p.A., EP 803 245 (hereafter Intercos '245). Roulier et al '814 and WO 97/17055 are characterized for their teachings in the above rejection combination. Said characterizations are herein incorporated by reference.

Roulier et al '814 differs in the concentration of said gelling agents in the solid gels and the combination of gelling agents taught in the prior art for said same purpose as gelling agents.

Intercos '245 (abstract; column 1, lines 21 et seq; and examples and claims) discloses a compact solid gel comprising a water, polysaccharides, humectants and a powder phase. Intercos '245 (column 1, lines 34-44) discloses the hydrophilic gelling

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overlapping those disclosed in Roulier et al '814 employed either singly or in combination including carageenan, agar, gellan, alginic acids and salts at (column 1, lines 27 and 28) a concentration of 0.3 to 4% by weight of the gels. Said concentrations read on the claimed concentration.

Intercos '245 (column 1, lines 45 et seq) teaches the compositions are advantageously thermoreversible and may further incorporate electrolyte salts, soaps, various excipients employed in cosmetics including various fillers and pigments.

These references are combinable because they teach cosmetic gels. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ gellan gum as an obvious exudates contemplated in the Roulier et al '814 compositions at concentrations of less than 20 % by weight to form the thermoreversible gels taught in the Intercos '245 reference.

It is generally prima facie obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, both the cellulose derivatives and the gellan gums are taught as gelling agents in the Roulier et al '814 reference.

Response to Arguments

6. Applicant's arguments filed March 12, 2003 have been fully considered but they are not persuasive.

7. Applicants' comments regarding claim interpretation are noted.

8. Applicants (page 6) assert the examiner asserts no legal basis for the rejection of claims under 35 USC 112 as indefinite as to the scope of the alternative groups. The legal basis is set forth in the MPEP section cited by the examiner. Applicants alternative groups employ open language and are deemed to be indefinite as to scope of the group and its members. See MPEP 2173.05(h).

9. Applicant (pages 6 to 7) assert the term derivatives has been defined in the specification and one having ordinary skill in the art would understand the scope of said terms. The language defining "protein derivatives" does not define "protein derivatives" "and derivatives thereof". See specifically claim 28.

10. Applicants (page 8) state Roulier II (US 6,280,750) fails as prior art due to an earlier date. This would be true if applicants had perfected their priority. Since this has yet to be done, the date of Roulier II is prior art under 102(e) and the corresponding foreign family members are prior art under 102(a).

11. Applicants (page 8) assert Roulier (US 6,045,814) teaches away from the instant invention since it teaches a concentration of "at least 20% by weight" rather than the claimed "greater than 0 to 20% by weight". This has not been deemed persuasive for the following reasons. (1) This has not been deemed persuasive since the claims overlap and the end-point of 20% by weight at least is anticipated.

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(2) Applicant has not shown the concentrations, at least above and below 20% by weight, to be unobvious in view of the prior art.

(3) Many of the gelling agents in both the references and instantly disclosed are products derived from naturally products and are art known to vary in their ability to gel and the concentrations required for gelling depending on the type and the source of the natural product. As pointed out in the Claim interpretation section of the last Office Action, the claims do not define the gel strength.

(4) the prior art teaches claimed gelling agents at concentrations claimed are known to produce solid gels as claimed.

12. Applicants (page 8) assert the rejection fails to address the use of cellulose derivatives in greater than zero to 20% by weight. This has not been deemed persuasive since the Roulier et al '814 (column 3, lines 15-40) teaches the use of cellulose derivatives in concentrations of 20% by weight in forming solid gels.

13. Applicants (pages 8 and 9) assert the examiner has presented no line of reasoning why the skilled artisan would choose gellan gum from the laundry list of gelling agents. Applicants further assert the EP '245 reference provides no suggestion or motivation to employ gellan gum. Applicants conclude the examiner has not provided sufficient reasons to combine the references to arrive at the instant invention.

This has not been deemed persuasive and applicants are directed to the case law cited in the rejection and associated reasoning set forth on pages 7 and 8 of the last Office Action, Paper No.14. The gelling agents are clearly shown in the prior art references as gelling agents for making solid gels having utility in cosmetics. Applicants

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do not refute said facts. The combination logically flows from said teachings and is generally *prima facie* obvious and is supported by a list of case law.

Applicants have presented no evidence or adequate reasoning to rebut said *prima facie* case of obviousness. Applicants have not shown any particular gelling agent (or combination) to be unexpected in view of the prior art.

Lastly, the references are directed not only to cosmetics but to solid cosmetic gels. It is within the state of the art in cosmetic formulating to determine the concentration of a particular gelling agent and/or combination of gelling agents to obtain a cosmetic gel as disclosed in the prior art while clearly recognizing that not all gelling agents will exhibit the same gel strength (properties) and some variation would be expected. Furthermore, the ordinary skilled artisan would have reasonably expected the formation of a solid gel when employing the gelling agents of the prior art alone or in combination for said use as gelling agents.

14. Lastly, applicants assert EP '245 does not employ cellulose derivatives. This has not been deemed persuasive since the prior art is considered as a whole and applicants have presented no reasoning why said EP '245 gelling agents would not function in the Roulier compositions for their disclosed function.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Samain et al, US 6,342,235, corresponds to WO 97/17053. Samain et al and WO 97/17053 are directed to solid cosmetic compositions employing

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gelling agents including cellulose derivatives at concentrations including the range of higher than 8% to 20% by weight.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, reading "Daniel S. Metzmaier".

Daniel S. Metzmaier
Primary Examiner
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DSM
June 2, 2003